

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/248231

MARK: TARLETON

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GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/main/trademarks.htm>

TTAB INFORMATION:

<http://www.uspto.gov/web/offices/dcom/ttab/index.html>

APPLICANT: White Rock Distilleries,
Inc.

**CORRESPONDENT'S
REFERENCE/DOCKET NO:**

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CORRESPONDENT E-MAIL ADDRESS:

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Applicant: White Rock Distilleries, Inc.

Trademark: TARLETON

Serial No.: 77/248231

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EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, White Rock Distilleries, Inc., has appealed the Trademark Examining Attorney's final refusal to register TARLETON under Section 2(e)(4), 15 U.S.C. §1052(e)(4); TMEP §1211, based on the mark being primarily merely a surname.

RELEVANT FACTS AND EVIDENCE

The applicant applied to register TARLETON for "gin; distilled spirits" under Trademark Act Section 1 (b). The mark was refused registration under Section 2(e)(4) as primarily merely a surname. The supporting evidence of surname significance was 767 surnames in the P-FIND nationwide directory of names. An inquiry as to significance of the term, including any geographical significance was made. The applicant's response argued that the evidence was not sufficient to find the mark primarily merely a surname. The applicant stated there was no significance other than trademark significance as applied to Applicant's goods. The Final Office Action added surname evidence including: (1) eighty (80) news reports, article excerpts from Lexis/Nexis®, and Internet excerpts and (2) an updated P-FIND search retrieving 793 listings of Tarleton as a surname. The Request for Reconsideration argued: (1) the mark was a rare surname used almost as often as a first name and attached the evidence of 650 first names from a public records person search database; and (2) that the mark was the phonetic equivalent of tarlatan and similar to "tartan" such that it would be viewed as "vaguely British-sounding and associated with tradition and formality." The denial of the Request for Reconsideration argued that the name was not so rare, and noted that even rare surnames can be refused under Section 2(e)(4); that the mark being a phonetic equivalent of an ordinary word does not change the surname significance of the mark; and introduced evidence of no dictionary definitions of "tarleton" in to the record. The applicant appealed. The Office reassigned this application to the undersigned examining attorney. This is the examining attorney's Appeal Brief.

ISSUE

The sole issue on appeal is whether the applicant's mark, TARLETON, is primarily merely a surname under the Trademark Act §2(e)(4).

ARGUMENT

The applicant's mark, TARLETON, is primarily merely a surname.

The primary significance of the mark to the purchasing public determines whether a term is primarily merely a surname. *In re Etablissements Darty et Fils*, 759 F.2d 15, 17-18, 225 USPQ 652, 653 (Fed. Cir 1985); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 831, 832, 184 USPQ 421, 422 (C.C.P.A. 1975) *see* TMEP §§1211, 1211.01.

The following five factors are used to determine whether a mark is primarily merely a surname:

- (1) Whether the surname is rare;
- (2) Whether anyone connected with applicant uses the term as a surname;
- (3) Whether the term has any recognized meaning other than as a surname;
- (4) Whether the term has the structure and pronunciation of a surname; and
- (5) Whether the term is sufficiently stylized to remove its primary significance from that of a surname.

In re Benthin Mgmt. GmbH, 37 USPQ2d 1332, 1333-34 (TTAB 1995); TMEP §1211.01.

The factors are addressed in order.

SURNAME IS NOT SO RARE

The issue of determining whether a surname is common or rare is not determined solely by comparing the number of listings of the surname in a computerized database with the total number of listings in that database, because even the most common surname would represent only a small fraction of such a database. Rather, if a surname appears routinely in news reports, articles and other media as to be broadly exposed to the general public, then such surname is not rare and would be perceived by the public as primarily merely a surname. *In re Gregory*, 70 USPQ2d 1792, 1795 (TTAB 2004); *see* TMEP §1211.01(a)(v).

The evidence of record establishes that the TARLETON is a surname. The listing of 767^[1] (and updated listing of 793^[2]) entries of Tarleton - as a surname - in the P-FIND directory database establishes Tarleton as a surname. The attachment of at least eighty (80) references of Tarleton as a surname in Lexis Nexis news reports and stories, and website/Internet evidence further shows that the surname is not rare and would be perceived by the public as a surname. Some specific examples are:

“the Tarleton twins”^[3] and “Dr. Roland Tarleton, motivational speaker specialist”^[4] and “movie star Zoe Tarleton wants to taken seriously”^[5] and “dashing Colonel Banastre Tarleton”^[6] and “war hero Banastre Tarleton”^[7] and “Jon Tarleton, a meteorologist.”^[8] Some of the website/Internet evidence refers to: “Gael Tarleton for Port Commission” and “This website is devoted to the Tarleton Family, wherever they may be throughout the world. Tribute is paid to Charles W. Tarleton for his exhaustive work “The Tarleton Family” and to Carrie Tarleton Goldsborough and Anna Goldsborough Fisher for their thorough compilation ‘Tarleton Records.’ “ and “Richard Tarleton, the most celebrated clown of his time” and “Jon Tarleton – Artist Profile and Gallery” and “On the Road with John Tarleton – formerly wrote as a news and sports reporter at several daily newspaper” and “Shane Tarleton” (blogger) and “Sean Tarleton – bassist” and “Tarleton Family Crest and Name History.”^[9]

Additionally, it is noted that even a rare surname may be unregistrable under Trademark Act Section 2 (e)(4) if its primary significance to purchasers is that of a surname. *E.g., In re Etablissements Darty et Fils*, 759 F.2d 15, 225 USPQ 652 (Fed. Cir. 1985); *In re Giger*, 78 USPQ2d 1405 (TTAB 2006); *see* TMEP §1211.01(a)(v). There is no minimum number of telephone directory listings needed to prove that a mark is primarily merely a surname. *See* TMEP §1211.02(b)(i); *see, e.g., In re Petrin Corp.*, 231 USPQ 902 (TTAB 1986).

NO ONE CONNECTED TO THE APPLICANT HAS THE MARK AS A SURNAME

The applicant has stated that no one connected to the applicant has the surname Tarleton and that as used in connection with applicant's goods, the mark merely has trademark significance. This issue does not weigh in favor or against the perception of Tarleton as a surname. The 2(e)(4) refusal is not based on the mark being a surname connected to the applicant, but was issued as an assessment of the mark determining that TARLETON would be perceived as a surname to the general public.

OTHER RECOGNIZED MEANINGS OF THE MARK

Evidence that a word has no meaning or significance other than as a surname is relevant to determining whether the word would be perceived as primarily merely a surname. *See In re Petrin Corp.*, 231 USPQ 902, 903 (TTAB 1986); TMEP §1211.02(b)(v). The evidence attached to the denial of the Request for Reconsideration from multiple online dictionaries shows that the word "tarleton" does not appear in the dictionary as an ordinary word. Thus, this word appears to have no ordinary meaning or significance other than as a surname.

The mark has been shown to have minor geographic significance. The fact that a term is shown to have some minor significance as a geographical term will not dissipate its primary significance as a surname. *In re Hamilton Pharms. Ltd.*, 27 USPQ2d 1939, 1943 (TTAB 1993); *In re Picone*, 221 USPQ 93, 95 (TTAB 1984); TMEP §1211.01(a)(iii).

The applicant stresses the mark as a phonetic equivalent of “tarlatan.” The fact that the surname is also the phonetic equivalent of an ordinary word does not change the surname significance of the term. See *In re Pickett Hotel Co.*, 229 USPQ 760 (TTAB 1986) (holding PICKETT still a surname, even though equivalent to the word “picket”). The test is whether the term would be perceived primarily as a surname, not solely as a surname. See TMEP §1211.01(a)(ii). Since the goods are not fabric nor do they have a particular connection with the United Kingdom, it is unlikely that consumers would even make an association between the applicant’s mark and the obscure word “tarlatan.” Additionally, the applicant’s arguments as to the similarities of the mark to “tartan” are of no relevance to the determination of whether “tarleton” is a surname.

The applicant argues the finding of Tarleton as a first name nearly as often as a surname in name search databases. The current practice of adopting last names for use as first names often does not change the way the public views a name. A surname used as a first name will often be first and foremost perceived as a surname and then understood, in context, as being used as a “unique” or “creative” first name. Such a mark, as used as a trademark on goods, would be most likely to be perceived as a surname (mistakenly or not as someone’s surname who is associated with the goods). And as used on liquor, such as “gin; distilled spirits” – it would likely be presumed to be the name of the founder of the company, similar to Jim Beam and/or Johnnie Walker.

Analogizing to surname HAMILTON in *In re Hamilton Pharmaceuticals, Ltd.*, 27 USPQ2d 1939, the court in that case contrasts such names as “Thomas,” “Allen,” “Mitchell,” “Stewart,” “James” and “Henry” which are commonly used as both surnames and given names with the evidence of record that shows “Hamilton” as a surname, but its usage as a given name is relatively small. Similarly, Tarleton is a surname, but its usage as a given (or first) name is relatively small. While the evidence of record of Tarleton as a surname includes widespread references to many different persons, the focus of applicant’s evidence of that of a single individual, Tarleton Gillespie, whose fame outside of the educational arena has not been shown. Applicant’s P-FIND evidence also has many “duplicates” or multiple references to

what appears to be a single individual e.g. Tarleton Alexander – over 10 references to a single Hawaii address; Tarleton Elliott – 7 Alabama addresses; Tarleton Beaty – 6 Alabama addresses; and Tarleton Cherry – 13 Florida addresses. Finally, none of the names listed with Tarleton as the first name have been shown as appearing in the news such that consumers would readily recognize this name as a first name. Therefore, the primary meaning of the mark to the public will be as a surname.

MARK HAS THE STRUCTURE AND PRONUNCIATION OF A SURNAME

Tarleton is a surname. It looks and sounds like a surname. The fact that a term looks and sounds like a surname may contribute to a finding that the primary significance of the term is that of a surname. *In re Giger*, 78 USPQ2d 1405, 1409 (TTAB 2006); *In re Gregory*, 70 USPQ2d 1792, 1796 (TTAB 2004); *In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564, 1566 (TTAB 1988); *In re Petrin Corp.*, 231 USPQ 902, 904 (TTAB 1986); *see* TMEP §1211.01(a)(vi).

NO STYLIZATION

The mark is in standard-character format. There is no stylization. This factor is not an issue in this case.

When the evidence of record and the five factors are considered and analyzed, it is clear that the applicant's mark would be perceived as primarily merely a surname.

CONCLUSION

The mark is primarily merely a surname. Tarleton is a surname and not so rare as it appears routinely in news stories and the media. It has the look and feel of a surname. Minor geographic and unique first name usages do not change the overall impression of the mark as primarily merely a surname. This is especially true as used in connection with the applicant's liquor goods, where it would be likely

perceived as a surname associated with a founder. That Tarleton is not the surname of the founder does not weigh against this surname refusal, but it is the likely belief of the purchasing public that the mark is a surname that is most relevant to finding it primarily merely a surname.

Accordingly, the examining attorney respectfully requests that the refusal to register under Section 2(e) (4) be affirmed.

Respectfully submitted,

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[1]
See listing of 1-100 of 767 entries from P-FIND database of Tarleton as a surname at the bottom of the November 19, 2007 Office Action.

[2]
See listing of all 793 entries from the updated P-FIND search of Tarleton as a surname at the bottom of the August 3, 2008 Office Action.

[3]
See excerpt story #34 at bottom of August 3, 2008 Office Action.

[4]
See excerpt story #36 at bottom of August 3, 2008 Office Action.

[5]
See excerpt story #40 at bottom of August 3, 2008 Office Action.

[6]
See excerpt story #51 at bottom of August 3, 2008 Office Action.

[7]
See excerpt story #52 at bottom of August 3, 2008 Office Action.

[8]
See excerpt story #137 at bottom of August 3, 2008 Office Action.

[9]
See attachments to August 3, 2008 Office Action.